

Serial No.: 10/743,239
Amendment Dated February 28, 2007
Reply to Office action of December 1, 2006.

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REMARKS

In the Office Action of December 1, 2006, claims 1-13 and 15-38 were rejected and claim 14 was objected to as being dependent on a rejected base claim but was indicated by the Examiner as allowable if rewritten in independent form. No Amendments have been made in this response. Allowance of pending claims 1-38 is respectfully requested.

Formal Matters

Finality of Action Unclear:

The Office Action of December 1, 2006 did not make clear whether the action was non-final or final. The Office Action Summary Page indicated the action was non-final, while the Examiner's comments at page 6, indicated that the action had been made final.

Improper Final Rejection:

The Examiner, in response to the Applicants' arguments in the previous Office Action Response dated August 30, 2006, appears to have withdrawn without comment the rejection of claims 1-9, 11-12, 18-19, 22-28, and 34-35 under 35 U.S.C. §102(e) as being anticipated by Johnson et al. US Patent 6,790,934. In addition, the Examiner has expanded the scope of the earlier rejection of claims 7, 15, 20-21, 26, 29-30, 37-38 under 35 U.S.C. §103(a) as being unpatentable over US Patent 6,790,934, or US Patent 6,790,934 in view of Caringi et al. US Patent 6,235,934, to include all of claims 1-13 and 15-38. The Applicants urge that under such circumstances, a final rejection was improper under MPEP 706.07(a) and should be withdrawn since the new ground of rejection was neither necessitated by Applicants' amendment of the claims (there have been no amendments made) nor was it based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). The Applicants thus respectfully request that the finality of the Office Action dated December 1, 2006 be withdrawn.

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Rejections Under 35 U.S.C. §103(a)

Claims 1-13, and 15-38 were rejected under 35 U.S.C. §103(a) as being unpatentable over Johnson et al. US Patent 6,790,934 (hereinafter the '934 reference), or the '934 reference in view of Caringi et al. US Patent 6,235,934 (hereinafter "the Caringi reference").

The rejection of claims 1-13 and 15-38 is respectfully traversed. Neither the '934 reference, the Caringi reference, nor any combination thereof discloses or suggests the instant invention. The Applicants in the last Office Action Response discussed the '934 reference at length and urge that the '934 reference neither discloses nor suggests the instant invention. The Caringi reference discloses methods for the preparation of aqueous solutions of hexasubstituted guanidinium salts and the use of these solutions for the reliable delivery of phase transfer catalysts to reaction mixtures. While the Caringi reference does disclose the addition of an aqueous solution of a hexasubstituted guanidinium salt to a reaction mixture and subsequent removal of water from the reaction mixture (See column 7 lines 27-28, column 8 lines 63-66, column 9 lines 12-14, Example 4, Example 5, and Example 6), the Caringi reference does not disclose any of the methods of separation recited by the Applicants' originally filed claims:

- (a) adsorption onto a carbonaceous adsorbent,
- (b) adsorption onto a clay adsorbent,
- (c) filtration through a nanofiltration membrane, or
- (d) removal of water and calcination.

The Caringi reference focuses on the preparation of aqueous solutions of hexasubstituted guanidinium salts and the fact that such aqueous solutions present a convenient means of adding known amounts of hexasubstituted guanidinium salts to reaction mixtures requiring a phase transfer catalyst. Thus, the Caringi reference is directed to an entirely different problem than that which the '934 reference addresses. The Caringi reference solves the problem of how to introduce a hexasubstituted guanidinium salt phase transfer catalyst into a reaction mixture reliably, while the '934

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reference addresses removal of organic guanidinium phase transfer catalysts from product mixtures comprising organic solvents. Neither reference addresses the removal of guanidine compounds from aqueous media. A combination of the '934 reference and the Caringi reference at most teaches the addition of a hexasubstituted guanidinium salt to an organic reaction mixture as an aqueous solution, followed by the separation of a hexasubstituted guanidinium salt from a product mixture comprising an organic solvent. Because no combination of the '934 reference and the Caringi reference can be read to disclose or suggest the instant invention, the Applicants respectfully request that the rejection of claims 1-13 and 15-38 under 35 U.S.C. §103(a) as being unpatentable over Johnson et al. US Patent 6,790,934, or US Patent 6,790,934 in view of Caringi et al. US Patent 6,235,934 be withdrawn.

In view of the foregoing remarks and arguments, the Applicants believe that claims 1-38 remain in condition for allowance. The Applicants thus courteously solicit prompt allowance of claims 1-38. Should the Examiner believe that anything further is needed to place the application in even better condition for allowance, the Examiner is requested to contact the Applicants' undersigned representative at the telephone number below.

Respectfully submitted,


Andrew J. Caruso
Reg. No. 48,520

General Electric Company
Building K1, Room 3A71
Niskayuna, New York 12309
February 28, 2007
Telephone: (518) 387-7354